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In re Application of SERVANT et al :  
U.S. Application No.: 10/563,758 :  
PCT Application No.: PCT/US2004/021853 :  
Int. Filing Date: 09 July 2004 : DECISION  
Priority Date Claimed: 10 July 2003 :  
Attorney Docket No.: 54315US :  
For: IMPROVED ELECTROPHYSIOLOGICAL :  
ASSAYS :

This is in response to applicant's "Petition for Revival of an Application for Patent Abandoned Unintentionally Under 37 CFR 1.137(b)", "Petition Under § 1.47(A) to Accept Joint Inventor Declarations That Fails to Include Signature of Inventor Imran Clark Who Cannot be Located After Diligent Efforts by Applicant", and "Petition Under 37 CFR 1.497(D) Relating to Oath or Declaration Under 35 USC 371(c)(4) Adding Additional Inventor Omitted in the International (PCT) Application Without Deceptive Intent" filed 06 March 2008.

**BACKGROUND**

On 09 July 2004, applicant filed international application PCT/US2004/021853, which claimed priority of an earlier United States application filed 10 July 2003. The thirty-month period for paying the basic national fee in the United States expired on 10 January 2006.

On 09 January 2006, applicant filed national stage papers in the United States Designated/Elected Office (DO/EO/US). The submission was accompanied by, *inter alia*, the basic national fee required by 35 U.S.C. 371(c)(1).

On 07 May 2007, the DO/EO/US mailed a Notification of Missing Requirements Under 35 U.S.C. 371 (Form PCT/DO/EO/905), which indicated that an oath or declaration in compliance with 37 CFR 1.497 must be filed.

On 09 July 2007, applicant filed an executed declaration.

On 24 September 2007, the DO/EO/US mailed a Notification of Defective Response (Form PCT/DO/EO/916), which indicated that inventive entity listed on the declaration filed 09 July 2007 differs from that listed on the international application.

On 08 October 2007, applicant filed a response to the Notification of Defective Response.

On 06 February 2008, this Office mailed a communication which indicated that the 08 October 2007 response did not fully remedy the deficiency noted in the Notification of Defective Response and that the present application is accordingly abandoned.

On 06 March 2008, applicant filed the present petitions under 37 CFR 1.137(b), 37 CFR 1.47(a), and 37 CFR 1.497(d).

## **DISCUSSION**

### **I. Petition Under 37 CFR 1.137(b)**

Under 37 CFR 1.137(b), a petition requesting that an application be revived on the grounds of unintentional abandonment must be accompanied by: (1) the required reply unless previously filed, (2) the petition fee as set forth in 37 CFR 1.17(m), (3) a statement that the entire delay in filing the required reply from the due date for the reply until the filing of a grantable petition was unintentional, and (4) a terminal disclaimer if the application was filed before 08 June 1995.

With regard to item (1), applicant has not provided the required reply under 35 U.S.C. 371 as discussed in §III below.

With regard to item (2), applicant has provided the required petition fee.

With regard to item (3), applicant has provided the required statement.

With regard to item (4), because the international application was filed after 08 June 1995, no terminal disclaimer is required.

### **II. Petition Under 37 CFR 1.47(a)**

The petition states that joint inventor Imran Clark cannot be located after diligent effort. However, the declaration filed 09 July 2007 is acceptable with respect to inventors Servant, Chang, Redcrow, and Clark, since pages 1-4 form a complete declaration, based on petitioner's statement that the "earlier submitted Declaration was signed by all of the inventors including Imran Clark (signature dated May 21, 2007)." This statement is construed as a representation that inventor Clark was presented with pages 1-4 of the declaration prior to his execution of the document. If this is an incorrect interpretation, petitioner is required to notify this Office.

Accordingly, a petition under 37 CFR 1.47(a) is not required with respect to inventor Clark.

The 09 July 2007 declaration is not acceptable with respect to inventors Ray and Moyer, because it is not proper to submit only the signature page of a declaration and then combine it with pages from another copy of the declaration. The 06 March 2008 submission of complete declarations executed by inventors Ray and Moyer puts the present application in compliance with 37 CFR 1.497(a).

### III. Petition Under 37 CFR 1.497(d)

The petition states that the sixth inventor was inadvertently omitted from the international application.

MPEP 1893.01(e) states in relevant part,

The inventorship of an international application entering the national stage under 35 U.S.C. 371 is that inventorship set forth in the international application, which includes any changes effected under PCT Rule 92bis. See 37 CFR 1.41(a)(4). Accordingly, an oath or declaration that names an inventive entity different than that set forth in the international application will not be accepted for purposes of entering the U.S. national phase unless the requirements under 37 CFR 1.497(d) are satisfied. These requirements include: (A) a statement from each person being added as an inventor and from each person being deleted as an inventor that any error in inventorship in the international application occurred without deceptive intention on his or her part; (B) the processing fee set forth in 37 CFR 1.17(i); and (C) the written consent of the assignee if an assignment has been executed by any of the original named inventors (see 37 CFR 3.73(b)).

Petitioner has provided items (A) and (B) above. Although a statement of consent from the purported assignee Senomyx, Inc. has been provided, ownership of the application has not been established in accordance with 37 CFR 3.73(b)(1). While a statement under 37 CFR 3.73(b) was filed on 26 April 2006, the copy of the assignment referenced in the 26 April 2006 37 CFR 3.73(b) statement is not present in the application file.

### CONCLUSION

For the reasons set forth in §I above, the petition under 37 CFR 1.137(b) is DISMISSED without prejudice.

For the reasons set forth in §II above, the petition under 37 CFR 1.47(a) is DISMISSED AS MOOT.

For the reasons set forth in §III above, the petition under 37 CFR 1.497(d) is DISMISSED without prejudice.

If reconsideration on the merits of the petitions is desired, a proper response must be filed within TWO (2) MONTHS from the mail date of this decision. Extensions of time are available under 37 CFR 1.136(a). Any reconsideration request should include a cover letter entitled "Renewed Petitions Under 37 CFR 1.137(b) and 37 CFR 1.497(d)". No additional petition fee is required.

Please direct further correspondence with respect to this matter to Mail Stop PCT, Commissioner for Patents, Office of PCT Legal Administration, P.O. Box 1450, Alexandria, Virginia 22313-1450, with the contents of the letter marked to the attention of the Office of PCT Legal Administration.



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